

1 via the Internet, the person inputs a telephone number that is stored
2 in a database. Respondents can then direct connect and initiate a
3 voice conversation by having the system call the advertiser's
4 telephone number, whether the respondent's call initiates from a
5 traditional telephone or from an Internet telephone. In addition, if
6 the advertiser is on-line, respondents can direct connect and initiate
7 a voice conversation with an advertiser, whether the respondent's call
8 initiates from a traditional telephone or from an Internet telephone.
9 In addition, if both the advertiser and respondent have video cameras
10 connected to their computers, they can initiate a video conference.
11 These features greatly enhance the communications between the
12 advertiser and the respondent while maintaining anonymity and
13 heightening personal security.

14 The significant advantages provided by the present invention are
15 apparent from the above description. The present invention provides
16 a more effective means of connecting individuals than previous
17 systems. Also, the system of the present invention does not require
18 the advertiser to divulge his or her telephone number to the public.
19 In addition, new advertisers can meet someone faster because they are
20 automatically connected with the chosen advertisers.

1 **II. THE EXAMINER'S REJECTIONS**

2 In the June 20, 2000 Office Action, the Examiner rejected claims
3 3, 5 and 8 under 35 U.S.C. §102(b) as being anticipated by Hyodo U.S.
4 Patent No. 5,937,390 (Hyodo). Regarding claim 3, in the opinion of
5 the Examiner:

6 "Hyodo discloses a method for providing an
7 enhanced computer based advertising system,
8 wherein [sic.] comprises the steps of:

9 an advertiser placing an advertisement
10 (figure 1, item 3);

11 storing advertisement (column 3, lines 13-
12 15);

13 publishing advertisement (column 3, lines
14 23-26);

15 receiving a first connection from a user via
16 the Internet in response to advertisement (column
17 4, lines 12-19);

18 initiating a second connection with
19 advertiser via telephone(column 4, 27-29); and

20 coupling first connection with second
21 connection, whereby a conversation between user

1 and advertiser ensues (column 4, lines 12-31);

2 wherein system is the receiver of first
3 connection, and wherein system performs
4 initiating and coupling (column 4, lines 12-31)."

5 Additionally, with respect to claims 5 and 8, the Examiner states that
6 "Hyodo discloses advertisement comprises text (figure 1, item 1)" and
7 "the step of charging user or advertiser (column 4, lines 50-55)."

8 The Examiner also rejected claim 4 under 35 U.S.C. § 103(a) as
9 being unpatentable over Hyodo in view of Solomon et al. US Patent No.
10 5,768,348 (Solomon). In the opinion of the Examiner:

11 "Solomon teaches the anonymity of advertiser
12 is maintained (see abstract). It would have been
13 obvious to one of ordinary skill in the art at
14 the time the invention was made to combine the
15 Solomon's above feature with Hyodo for the
16 purpose of keeping the anonymity between the user
17 and the advertiser."

18 Next, the Examiner rejected claim 9 under 35 U.S.C. § 103(a) as
19 being unpatentable over Hyodo in view of Reilly et al. US Patent No.
20 5,740,549 (Reilly). In the opinion of the Examiner:

21 "Hyodo discloses a method for providing an

1 enhanced computer based advertising system,
2 wherein [the] comprises the steps of:

3 an advertiser placing an advertisement
4 (figure 1, item 3);

5 storing advertisement (column 3, lines 13-
6 15);

7 publishing advertisement (column 3, lines
8 23-26);

9 receiving a first connection from a user via
10 the Internet in response to advertisement (column
11 4, lines 12-19);

12 coupling first connection with second
13 connection, whereby a conversation between user
14 and advertiser ensues (column 4, lines 12-31);

15 wherein system is the receiver of first
16 connection, and wherein system performs
17 initiating and coupling (column 4, lines 12-31).

18 However, Hyodo does not teach the step of
19 initiating a second connection with advertiser
20 via Internet. Reilly teaches the step of
21 initiating a second connection with advertiser

1 via Internet (column 13, lines 9-25)."

2 From this, the Examiner concluded that:

3 "[i]t would have been obvious to one with
4 ordinary skill in the art at the time the
5 invention was made to combine the step of
6 initiating a second connection with advertiser
7 via Internet with Hyodo's method for the purpose
8 of connecting user and advertiser in order to
9 ensure the communication between user and
10 advertiser."

11 Next, the Examiner rejected claims 6-7, 15, 17-20 25 and 41-50
12 under 35 U.S.C. § 103(a) as being unpatentable over Hyodo in view of
13 an Official Notice taken by the Examiner. In the opinion of the
14 Examiner, the following warranted the taking of Official Notice: "that
15 advertisement comprises audio and video is well known in the art";
16 "that establishing a communication via an Internet telephone call
17 which is initiated from a Web page is well-known in the art"; "that
18 establishing a real-time Internet communication is well known in the
19 art"; and "that advertiser places a plurality of contact numbers in
20 the advertisement and system executes sequence in advertiser specified
21 order is well known in the art."

1 In addition, the Examiner reiterated that:

2 "Hyodo discloses a method for providing an
3 enhanced computer based advertising system,
4 wherein [the] comprises the steps of:

5 an advertiser placing an advertisement
6 (figure 1, item 3);

7 storing advertisement (column 3, lines 13-
8 15);

9 publishing advertisement (column 3, lines
10 23-26); and

11 a user accessing advertisement via the
12 Internet (column 4, lines 12-19).

13 However, Hyodo does not teach the step of:
14 user responding to advertisement via an Internet
15 telephone call; wherein Internet telephone call
16 is initiated from Web page."

17 From this, the Examiner concluded that it would have been obvious to
18 one with ordinary skill in the art at the time the invention was made
19 to "include audio/video in Hyodo's advertisement in order to stimulate
20 the user to purchase goods or services over the public network", "to
21 combine the step of user responding to advertisement via an Internet

1 telephone call with Hyodo's method for the purpose of establishing a
2 telephony communication between user and advertiser over the
3 Internet", "to combine the step of: responding to advertisement via a
4 real time Internet communication with Hyodo's method for the purpose
5 of obtaining a real-time communication between user and advertiser
6 over the Internet", and "to combine those feature above with Hyodo's
7 method for the purpose of allowing user can easily reaches the
8 advertiser."

9 Applicant firmly believes that the above amendments and the
10 comments that follow will convince the Examiner that these rejections
11 should be reconsidered and withdrawn. In short, applicant
12 respectfully submits that the Examiner's understanding of the present
13 invention as well as his application of the prior art is misplaced.
14

15 **III. THE EXAMINER'S REJECTIONS SHOULD BE RECONSIDERED**

16 Applicant respectfully submits that the claims, as amended, are
17 neither anticipated nor rendered obvious by the cited references. On
18 further reflection, we are confident that the Examiner will recognize
19 that any rejections based on Hyodo U.S. Patent No. 5,937,390 (Hyodo)
20 could only be the result of a hindsight reconstruction of the
21 applicant's invention, and that the Examiner's interpretation of the

1 prior art is misplaced.

3 CLAIMS 3-8

4 The Examiner rejected claim 3, 5 and 8 under 35 U.S.C. §102 as
5 being anticipated by Hyodo. In the opinion of the Examiner, Hyodo
6 discloses a method for providing an enhanced computer based
7 advertising system comprising, in relevant part, the steps of
8 "receiving a first connection from a user via the Internet in response
9 to advertisement (column 4, lines 12-19)", "initiating a second
10 connection with advertiser via telephone(column 4, 27-29)" and
11 "coupling first connection with second connection, whereby a
12 conversation between user and advertiser ensues (column 4, lines 12-
13 31)."

14 Rather, applicant submits that Hyodo merely teaches the use of
15 the Internet to access or view an advertisement. This is not the
16 claimed invention. In fact, nowhere in the cited reference does Hyodo
17 teach responding to an advertisement via an Internet connection, as
18 suggested by the Examiner. Conversely, column 4, lines 12-19 of Hyodo
19 (i.e., the written description on which the Examiner relies in support
20 of his rejection) merely discloses giving a user a toll free number
21 and storing information about the user in an access log. Moreover,

1 Hyodo goes on to teach that in order to respond to an advertisement,
2 a user must call the toll free number using a telephone. This is
3 described at column 4, lines 20-21, and is shown in Fig. 3, item 7:
4 "To Order, Please Call 0120-XXXXXX." Clearly this is different from
5 the applicant's claimed invention wherein a user may respond to an
6 advertisement using the Internet by coupling an Internet connection
7 with a telephonic connection -- Hyodo does not address the problem of
8 responding to an advertisement in this manner.

9 In contrast, Hyodo teaches a method for tracking the
10 effectiveness of an advertisement by giving users a toll free number
11 to respond to advertisements via telephone. The log of calls made via
12 the toll free number is then compared to users' Internet usage to
13 calculate a ratio of toll free calls to web "hits". Hyodo teaches
14 that this ratio is indicative of an advertisement's effectiveness.
15 This analysis is detailed in column 5, lines 26-54. Nowhere does
16 Hyodo disclose coupling a first Internet [VOICE???] connection with a
17 second telephonic connection whereby a [VOICE???] conversation with a
18 user and advertiser ensues.

19 Applicant therefore submits that claims 3, 5 and 8 are patentably
20 distinct over Hyodo in that Hyodo does not disclose "coupling said
21 first voice connection with said second voice connection, whereby a

1 voice conversation between said user and said advertiser ensues."

2 Next, the Examiner rejected claims 4-8 under 35 U.S.C. §102
3 and/or 35 U.S.C. §103. As demonstrated above, Hyodo does not teach
4 each and every element of claim 3, and therefore also does not teach
5 each and every element of dependant claims 4-8. Therefore, applicant
6 submits that claims 4-8 are neither taught nor rendered obvious by the
7 cited references, and are believed to be in condition for allowance.

8
9 CLAIMS 9-14

10 Next, the examiner rejected claim 9 under 35 U.S.C. §103 as being
11 unpatentable over Hyodo in view of Reilly *et al.* U.S. Patent No.
12 5,740,549 (Reilly). In the opinion of the Examiner, in addition to
13 the elements discussed above regarding claims 3, 5 and 8, Reilly
14 discloses the step of initiating a second connection with an
15 advertiser via the Internet (Reilly col. 13, lns. 9-25).
16 Respectfully, applicant submits that the Examiner's reliance on Reilly
17 is misplaced. Reilly does not teach a step of initiating a second
18 connection via the Internet whereby a voice conversation between a
19 user and an advertiser ensues, as claimed in the present application.
20 The "connection" disclosed by Reilly is merely a link to an additional
21 Web page for the user to obtain additional information about a

1 particular advertisement (Reilly col. 13, lns. 9-25). This is not the
2 present invention.

3 In addition, the Examiner states that Hyodo discloses the step
4 of, "coupling said first connection with said second connection."
5 Applicant submits that this reliance on Hyodo is also misplaced. That
6 is, Hyodo does not teach the coupling of connections, as demonstrated
7 above. Rather, Hyodo teaches that a user may make a standard
8 telephone call to respond to an advertisement, as clearly shown by
9 Hyodo's FIG. 3, item 7: "To Order, Please Call 0120-XXXXXX" and its
10 associated description. Therefore, applicant respectfully submits
11 that claim 9 is patentably distinct over both Reilly and Hyodo, and
12 thus is in condition for allowance.

13 Next, the Examiner rejected claim 11 under 35 U.S.C. §102, and
14 rejected claims 10, and 12-14 under 35 U.S.C. §103. As demonstrated
15 above, Hyodo does not teach each and every element of claim 9, and
16 therefore also does not teach each and every element of dependant
17 claims 10-14. Therefore, applicant submits that claims 10-14 are
18 neither taught nor rendered obvious by the cited references, and are
19 believed to be in condition for allowance.

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In particular, at the time of the invention (as well as the time of filing this application) there was no use made of Internet telephony or real-time Internet communications to respond to advertisements. Moreover, none of the references relied upon or cited by the Examiner contain any justification to support the use of an Internet telephone call to respond to an advertisement. Therefore, applicant must disagree with the Examiner's taking Official Notice as described above, and respectfully requests that support for such Official Notice be cited.

- 18 -

1 well known that for prior-art references to be validly combined in a
2 rejection under 35 U.S.C. §103, the reference or references must
3 suggest their combination. For example, as was stated in In re
4 Sernaker, 217 U.S.P.Q. 1, 6 (C.A.F.C. 1983),

5 "prior art references in combination do not make
6 an invention obvious unless something in the
7 prior art references themselves would suggest the
8 advantage to be derived from combining their
9 teachings."

10 Furthermore, the applicant respectfully points out that there is
11 no justification for the combination asserted by the Examiner (i.e.,
12 combining Hyodo and Internet telephony as Officially Noticed).

13 "Obviousness cannot be established by
14 combining the teachings of the prior art to
15 produce the claimed invention, absent some
16 teaching or suggestion supporting the
17 combination. Under section 103, teachings of
18 references can be combined only if there is some
19 suggestion or incentive to do so." ACS Hospital
20 Systems Inc. v. Montefiore Hospital, 732 F.2d
21 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)

(emphasis in original).

There is no such suggestion or incentive for the combination suggested by the Examiner. Therefore, the obviousness rejection could only be the result of a hindsight view with the benefit of the applicant's specification. However,

"To draw on hindsight knowledge of the patented invention, when the prior art does not contain or suggest that knowledge, is to use the invention as a template for its own reconstruction -- an illogical and inappropriate process by which to determine patentability. The invention must be viewed not after the blueprint has been drawn by the inventor, but as it would have been perceived in the state of the art that existed at the time the invention was made." (citations omitted)

Sesonics v. Aerosonic Corp. 38 USPQ 2d 1551, 1554 (1996).

In addition, the combination advanced by the Examiner is not legally proper -- on reconsideration the Examiner will undoubtedly recognize that such a position is merely an "obvious to try" argument. The disclosures of Hyodo does not reveal any other functional or

1 design choices that could possibly include that of the applicant's
2 invention. Accordingly, it is not obvious to combine Hyodo and
3 Internet telephony to arrive at the present invention. At best it
4 might be obvious to try such a modification. Of course, "obvious to
5 try" is not the standard for obviousness under 35 U.S.C. §103.
6 Hybritech, Inc. v. Monoclonal Antibodies, Inc., 231 USPQ 81, 91 (Fed.
7 Cir. 1986).

8 Under the circumstances, applicant respectfully submits that the
9 Examiner has succumbed to the "strong temptation to rely on
10 hindsight." Orthopedic Equipment Co. v. United States, 702 F.2d 1005,
11 1012, 217 USPQ 193, 199 (Fed. Cir. 1983):

12 "It is wrong to use the patent in suit as a
13 guide through the maze of prior art references,
14 combining the right references in the right way
15 so as to achieve the result of the claim in suit.
16 Monday morning quarter backing is quite improper
17 when resolving the question of non-obviousness in
18 a court of law." Id.

19 Applicant submits that the only "motivation" for the Examiner's
20 combination is provided by the teachings of applicant's own
21 disclosure. No such motivation is provided by the reference itself.

1 As was further stated in Uniroyal Inc. v. Rudkin-Wiley Corp., 5
2 U.S.P.Q.2d 1434 (C.A.F.C. 1988), "[w]here prior-art references require
3 selective combination by the court to render obvious a subsequent
4 invention, there must be some reason for the combination other than
5 the hindsight gleaned from the invention itself . . . Something in the
6 prior-art must suggest the desirability and thus the obviousness of
7 making the combination." See also, Ex parte Levengood, 28 U.S.P.Q.2d
8 1300 (P.T.O.B.&I. 1993).

9 In the present case, the Examiner provides no support from the
10 reference(s) to justify the proposed combination, other than the
11 stating that such a system would have been obvious. The fact that the
12 combination produces an advantage (i.e., convenience of use) further
13 demonstrates the improvement applicant has found, establishing that
14 the combination produces new and unexpected results, and hence is
15 unobvious.

16 Applicant therefore submits that combining Hyodo with Internet
17 telephony or real time Internet communications is not legally
18 justified and is therefore improper. Thus, applicant requests that
19 the rejection of claims 15 and 25 be reconsidered and withdrawn.

20 Next, the Examiner also rejected dependent claims 16-24
21 (dependent on claim 15) and 26-34 (dependent on claim 15) under 35

1 U.S.C. §103. As demonstrated above, independent claims 15 and 25 are
2 neither taught nor rendered obvious by the cited references even in
3 view of the Official Notice taken by the Examiner, despite applicant's
4 disagreement with the taking of such Official Notice. Therefore,
5 dependent claims 16-24 and 26-34 are also not taught or rendered
6 obvious by the cited references and are believed to be in condition
7 for allowance.

8
9 CLAIMS 35-40

10 Next, the Examiner rejected claim 35-40 as containing the same
11 limitations as claims 3-8 (i.e., under 35 U.S.C. §102 as being
12 anticipated by Hyodo). As discussed above with respect to claims 3-8,
13 applicant submits that claims 35-41 are patentably distinct over Hyodo
14 in that Hyodo does not disclose "coupling said first voice connection
15 with said second voice connection, whereby a voice conversation
16 between said user and said advertiser ensues." Therefore, applicant
17 submits that claims 35-41 are neither taught nor rendered obvious by
18 the cited references, and are believed to be in condition for
19 allowance.

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Furthermore, the applicant respectfully points out that there is no justification for the combination asserted by the Examiner (i.e., combining Hyodo and the Official Notice taken by the Examiner).

"Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some

1 suggestion or incentive to do so." ACS Hospital
2 Systems Inc. v. Montefiore Hospital, 732 F.2d
3 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)
4 (emphasis in original).

5 There is no such suggestion or incentive for the combination suggested
6 by the Examiner. Therefore, the obviousness rejection could only be
7 the result of a hindsight view with the benefit of the applicant's
8 specification. However,

9 "To draw on hindsight knowledge of the patented
10 invention, when the prior art does not contain or
11 suggest that knowledge, is to use the invention
12 as a template for its own reconstruction -- an
13 illogical and inappropriate process by which to
14 determine patentability. The invention must be
15 viewed not after the blueprint has been drawn by
16 the inventor, but as it would have been perceived
17 in the state of the art that existed at the time
18 the invention was made." (citations omitted)
19 Sesonics v. Aerosonic Corp. 38 USPQ 2d 1551, 1554
20 (1996).

21 In addition, the combination advanced by the Examiner is not

1 legally proper -- on reconsideration the Examiner will undoubtedly
2 recognize that such a position is merely an "obvious to try" argument.
3 The disclosures of Hyodo does not reveal any other functional or
4 design choices that could possibly include that of the applicant's
5 invention. Accordingly, it is not obvious to combine Hyodo and
6 Internet telephony to arrive at the present invention. At best it
7 might be obvious to try such a modification. Of course, "obvious to
8 try" is not the standard for obviousness under 35 U.S.C. §103.
9 Hybritech, Inc. v. Monoclonal Antibodies, Inc., 231 USPQ 81, 91 (Fed.
10 Cir. 1986).

11 Under the circumstances, applicant respectfully submits that the
12 Examiner has succumbed to the "strong temptation to rely on
13 hindsight." Orthopedic Equipment Co. v. United States, 702 F.2d 1005,
14 1012, 217 USPQ 193, 199 (Fed. Cir. 1983):

15 "It is wrong to use the patent in suit as a
16 guide through the maze of prior art references,
17 combining the right references in the right way
18 so as to achieve the result of the claim in suit.
19 Monday morning quarter backing is quite improper
20 when resolving the question of non-obviousness in
21 a court of law." Id.

1 Applicant submits that the only "motivation" for the Examiner's
2 combination is provided by the teachings of applicant's own
3 disclosure. No such motivation is provided by the reference itself.

4 Moreover, even if the combination suggested by the Examiner was
5 proper, such a combination would still not teach or render obvious the
6 present invention. In particular, such a combination fails to teach
7 a system using an Internet telephone call or a real-time Internet
8 communication to respond to an advertisement whereby at least one of
9 said connections to said contact numbers is via the Internet, as
10 claimed in the present application. Therefore, applicant requests
11 that this rejection be reconsidered and withdrawn.

12 The Examiner also rejected dependent claims 42-46 and 48-50 under
13 35 U.S.C. §103. As demonstrated above, independent claim 41 is
14 neither taught nor rendered obvious by the cited references even in
15 view of the Official Notice taken by the Examiner, despite applicant's
16 disagreement with the taking of such Official Notice. Therefore,
17 dependent claims 42-46 and 48-50 are also not taught or rendered
18 obvious by the cited references and are believed to be in condition
19 for allowance.

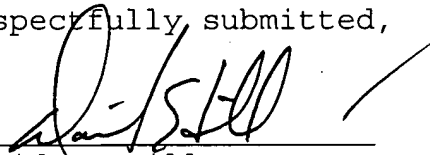
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21 In sum, the present invention, for the first time, discloses a

1 novel system for the use of an Internet telephone call to respond to
2 advertisements. This represents a vast improvement over the prior
3 art, and is not taught or disclosed anywhere in the prior art.
4 Further, the cited references neither teach nor suggest the novel and
5 nonobvious features of this invention.

6
7 **CONCLUSION**

8 In view of the foregoing, applicant respectfully submits that the
9 present invention represents a patentable contribution to the art and
10 the application is in condition for allowance. Early and favorable
11 action is accordingly solicited.

Respectfully submitted,



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